

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PETER J. JAERLING

Appeal No. 98-0904
Application No. 08/500,033¹

ON BRIEF

Before MEISTER, FRANKFORT, and NASE, ***Administrative Patent Judges.***

MEISTER, ***Administrative Patent Judge.***

DECISION ON APPEAL

Peter J. Jahrling (the appellant) appeals from the final rejection of claims 1, 5, 6, 11-13, 20 and 21, the only claims remaining in the application.

¹ for patent filed July 10, 1995. According to appellant, this application is a continuation of Application 08/109,970 filed August 23, 1993, now abandoned.

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We REVERSE.

The appellant's invention pertains to (1) an infrared detection system and (2) an electrical control system for controlling the flush valve of a toilet device that utilizes such an infrared detection system. Independent claims 1 and 11 are further illustrative of the appealed subject matter and a correct copy of claim 1 may be found in the appendix to the answer and a correct copy of claim 11 may be found in the appendix to the brief.

The examiner has relied on the following references as evidence of obviousness:

O'Neill	4,069,812	Jan. 24, 1978
Kahl et al. (Kahl)	4,703,171	Oct. 27, 1987
Whiteside 1992	5,169,118	Dec. 8,

The appellant has relied on a self-executed declaration as evidence of nonobviousness.²

² Since we are not of the opinion that the prior art relied on by the examiner establishes a *prima facie* case of obviousness, we need not consider the appellant's evidence of nonobviousness. *In re Fine*, 837 F.2d 1071, 1076, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

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Claims 1, 5, 6, 11-13, 20 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Whiteside in view of Kahl and O'Neill. According to the examiner:

Whiteside teaches the claimed environment of use of an infrared detector. Kahl et al teach the use of a Fresnel type refraction in a proximity detecting environment and O'Neill teaches the specific lens employed in the instant device. It would have been obvious to employ a Fresnel refraction lens as taught by Kahl et al in the similar environment as taught by Whiteside and to further provide for the lens to be of the type taught by O'Neill. The Kahl et al reference is applied solely as evidence that refractive lens are known to be employed in the infrared sensor environment to redirect beams to desired locations. This provides the nexus for the combination with O'Neill where the claimed refraction lens is taught. With respect [to] the "means separating said thin films" the ordinary artisan would certainly find [sic, have found] it obvious to separate the respective beams if conflict between the two occurred.

It is axiomatic that the ordinary artisan would be presumed to recognize the need to direct light beams to desired locations particularly in the instant case where the recognized problem is created by dislocation of the transmitter and or receiver. The solution to the created problem of misdirected beams is to redirect them. The examiner contends that the ordinary artisan would have found it obvious to employ the O'Neill lens in the Whiteside environment as the use of a beam path adjuster in a beam path environment would have constituted a prima facie [sic, facie] case of obviousness. Offered as further evidence of this is Kahl, where the infrared

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environment is taught with the use of a Fresnel lens. [Answer, pages 3 and 4.]

We will not support the examiner's position. The mere fact that Kahl, as a broad proposition, teaches the use of refractive lenses to redirect beams in an infrared sensor does not serve as a proper motivation for incorporating O'Neill's Fresnel lens into the device of Whiteside as the examiner apparently believes. Instead, it is well settled that it is the teachings of the prior art taken as a whole which must provide the motivation or suggestion to combine the references. ***See In re Fritch***, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992) and ***Uniroyal, Inc. v. Rudkin-Wiley Corp.***, 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988).

Here, we find no such motivation or suggestion. Whiteside teaches an infrared detection system that includes a transmitter and detector, and is used for controlling the flush valve of a toilet device. As the examiner recognizes, Whiteside does not teach the use of a refracting means that includes a film having a plurality of prisms thereon. In an attempt to overcome this deficiency the examiner has relied on

the teachings of Kahl and O'Neill. Kahl and O'Neill, however, are directed to completely disparate types of devices. That is, although Kahl teaches the use of an infrared detector having a refraction means that includes a Fresnel lens, Kahl's infrared detector is of the wide- angle **passive** type that is used to automatically turn the lights of a room on when it is occupied and off when it is not. To this end, Kahl utilizes the passive type detector to sense a change "in the **heat** received within its field of view" (column 2, lines 24 and 25; emphasis added) and, in response to the change in heat, produces a signal which causes the lights in the room to be turned on and off. O'Neill, while teaching a Fresnel lens having

prisms thereon, is in no way concerned with infrared detection. Instead, O'Neill utilizes the Fresnel lens to concentrate sunlight on a collector or "absorber" 24 for the purpose of converting light energy to heat. Absent the appellant's own disclosure, we are at a complete loss to understand why one having ordinary skill in this art would

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have been motivated to combine the disparate teachings of Whiteside, Kahl and O'Neill in the manner proposed by the examiner. In our view, the examiner has impermissibly relied upon the appellant's own teachings in arriving at a conclusion of obviousness. As the court in **Uniroyal**, 837 F.2d at 1051, 5 USPQ2d at 1438 stated "it is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention."

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The decision of the examiner to reject claims 1, 5, 6,
11-13, 20 and 21 under 35 U.S.C. § 103(a) based on the
combined teachings of Whiteside, Kahl and O'Neill is reversed.

REVERSED

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JAMES M. MEISTER)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
CHARLES E. FRANKFORT)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
JEFFREY V. NASE)	
Administrative Patent Judge)	

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